

REMARKSFORMAL MATTERS

Claims 1, 3-17, 19, and 23 are now pending.

Claims 18, 20-22 and 24 are cancelled without prejudice.

No other amendments are made. No new matter is added.

Applicants would like to note that an attempt was made to discuss this application by telephone and a voicemail was left with Examiner Hughes by Graham McKinnon, the agent of record. However, no return call was received by the agent of record.

REJECTIONS UNDER § 101

The Examiner rejected claims 20, 21 and 24 under this section. Applicants submit that the rejections under this section are rendered moot by virtue of the claims at issue having been cancelled without prejudice.

REJECTIONS UNDER § 112

The Examiner rejected claims 20, 21 and 24 under this section. Applicants submit that the rejections under this section are rendered moot by virtue of the claims at issue having been cancelled without prejudice.

REJECTIONS UNDER § 103(a)

The Examiner rejected all of the previous claims for being obvious in view of Lin *et al.* The Examiner indicates that the scope of the pending claims exceeds the scope of the unexpectedly faster results. This is simply not true. If a person of skill in the art were to practice the steps of claim 1, then the better results would be realized. Furthermore, the Examiner fails to provide any rationale or reasoning to support the bald allegation that the scope of the claims exceeds the better results that are clearly set out in the specification as originally filed. The Examiner is respectfully directed to MPEP 707.07(f), on page 700-126, where the first paragraph states:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

The Examiner persistently uses the phrase "because of the open claim language comprising encompasses the scope of the full invention". Applicants request the Examiner to clarify what this statement means. In our previous communication to the Office dated September 30, 2009, the Applicants made a good faith attempt address the possible concerns of the Examiner regarding this phrase and no response to the Applicants' remarks have been provided by the Examiner. The Examiner is once again respectfully directed to MPEP 707.07(I), page 700-126 where it states at the 3rd paragraph:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

In column 2 of page 700-126, it states in the 3rd paragraph:

The importance of answering the applicant's arguments is illustrated by *In re Herrmann*, 261 F.2d 598, 120 USPQ 182 (CCPA 1958) where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable. See also *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995) (Office filed to rebut applicant's argument).

For the sake of clarity, the substance of the Applicants' arguments are represented below.

The Examiner states that the Applicant's previous arguments are not persuasive "because of the open claim language comprising encompasses the scope of the full invention". By this statement the Applicant understands that it is the Examiner's belief that the processes described in *Liu et al* render the present application obvious. The

Applicant disagrees. In order for there to be a prima facie case of obvious all of the elements need to be found in the prior art. The Applicant would like the Examiner to identify the location of step (b) of the claim 1 of the present application in the cited art. Use of the word “comprising” in claim 1 of the present application does not change the nature of step (b) in which it is clear that addition of the atorvastatin sodium salt to an aqueous calcium chloride or calcium acetate solution is essential. The word “comprising” does not affect the nature of this step (b) and hence the Applicant is somewhat puzzled by the Examiner’s insistence that the “open claim language comprising” is problematic.

Alternatively, if the Examiner is of the opinion that the word “comprising” of claim 1 of Lin *et al.* is problematic, then Applicant submits that such an approach is unsuitable on the basis that all other processes, whether or not they were for making atorvastatin or any other compound by any other method would be encompassed by this logic. The word “comprising” as used in claim 1 of Lin *et al.* does not render obvious a claim to a process comprising all of the same steps and an additional step or a claim with less than all of the steps of claims 1 of Lin *et al.*. Furthermore, the word “comprising” as set out in claim 1 of Lin *et al.* does not teach that you must add the atorvastatin sodium salt to the aqueous calcium chloride or calcium acetate solution, as required by claim 1 of the present application.

The Examiner is respectfully requested to withdraw the rejection.

The Examiner further rejects claims 4-7 under 35 U.S.C. § 103(a) over Lin *et al.* in view of Tessler *et al.* Applicant respectfully submits that a prima facie case of obvious has still not been provided on the basis that step (b) of claim 1, from which each of claims 4-7 are ultimately dependent, is not taught anywhere in the prior art and it is this step that provides for the unexpected advantages that the Examiner has expressly accepted as being unexpected advantages of the presently claimed processes. The Examiner is respectfully requested to withdraw the rejection.

CONCLUSION

In view of the above amendments and remarks, Applicants respectfully request consideration and allowance of claims. A good faith effort has been made to fully respond to the outstanding Office Action. However, should any further matter require attention, the Examiner is requested to contact the undersigned at the number provided below.

The pending claims are believed to satisfy all of the criteria for patentability and are in condition for allowance. An early indication of the same is therefore kindly requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided below.

No fees beyond those submitted herewith are believed to be due in connection with this communication. However, the Commissioner is authorized to charge any underpayment of fees associated with this communication under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-4648, order number **P1054US00**.

Respectfully submitted,
MCKINNON PATENTS,

Date: NOVEMBER 19, 2010

By: 

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